

is configured to calculate presumed execution time to carry out a predetermined scope of the synthesizing process before the predetermined scope of the synthesizing process is actually carried out.

The outstanding Office Action asserts that, in Sugarman et al., the computer inherently calculates the amount of time necessary for the reaction process to progress from beginning to end.¹ However, Sugarman et al. do not disclose and even imply an execution time calculator that is configured to calculate presumed execution time to carry out a predetermined scope of the synthesizing process **before** the predetermined scope of the synthesizing process is actually carried out. Instead, Sugarman et al. merely disclose a control computer that controls valves and a vortexing motor during the synthesis process based on data acquired from sensors, and control software that issues commands to the components of the Sugarman et al. synthesizer during a synthesizing process.²

MPEP 2112 states that examiner must provide rational or evidence tending to show inherency:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that **the missing descriptive matter is necessarily present in the thing described in the reference**, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.**’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

“In relying upon the theory of inherency, the examiner must

¹ The outstanding Office Action, page 3, lines 2-4.

² See Sugarman et al., column 16, line 19 to, line 23 and column 18, line 32 to, line 36 and Fig. 1.

provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant’s invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was “formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material.” *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl’s balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).³

Although the Examiner’s assertion is based on the description at col. 20, lines 49-54 in the Sugarman et al. reference, this description does not necessarily disclose that the computer calculate presumed execution time to carry out a predetermined scope of the synthesizing process before the predetermined scope of the synthesizing process is actually carried out.

Further, even if a computer inherently clocks, this does not necessarily mean that the computer calculate presumed execution time to carry out a predetermined scope of the synthesizing process before the predetermined scope of the synthesizing process is actually carried out.

Therefore, the structure recited in Claim 1 is clearly distinguishable from Sugarman et al. Thus, Claim 1 is believed to be allowable.

Likewise, Claim 17 includes subject matter substantially similar to what is recited in Claim 1 to the extent discussed above. Thus, Claim 17 is believed to be allowable.

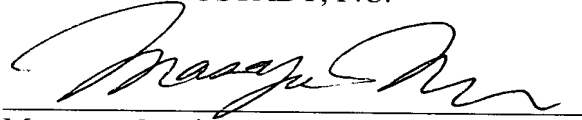
³ Bold provided.

Furthermore, since Claims 2-16 depend directly or indirectly from Claim 1, substantially the same arguments set forth above also apply to these dependent claims. Hence, Claims 2-16 are believed to be allowable as well.

In view of the amendments and discussions presented above, Applicants respectfully submit that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

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